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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT of William Possidento  
Patent No: 6,342,127  
Issue Date: 01/29/2002  
Application No.: 08/940203  
Filed: 09/29/1997  
For: Distillation device

Docket: WP71611

Commissioner of Patents and Trademarks  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

**Petition for Reconsideration under 37 CFR 1.378(e)**

1. The petition for reinstatement of the above mentioned patent having been dismissed, Petitioner hereby files for reconsideration.

As stated in the petition, this patent became lapsed unavoidably. Petitioner Possidento had relied on his former Patent attorney, John Halvonik, to keep him abreast of the scheduling of maintenance fees for the above mentioned patent. Halvonik's registration was suspended in 2005, and from 11/06 to the present. Possidento was unaware that Mr Halvonik's registration was suspended and did not receive correspondence from the PTO as his (applicant's) address was not listed as the correspondence address. Possidento did not receive notice regarding the issue fee from Halvonik. Accordingly, Mr. Possidento was not aware that the patent had lapsed.

Patentee became aware that the patent had expired in late September of 2011. Patentee was in the practice of searching the internet to view the status of his patent not realizing that the database which he was using did not show this information. As some time had passed since Mr Halvonik had contacted him, he decided to contact Halvonik to determine the maintenance fee status. At this point Halvonik informed him of his suspension and told him his patent had expired.

In dismissing the petition, the PTO states, inter alia, that petitioner must show that he was aware of the need to pay the maintenance fee, and was engaged in tracking the fee by some means. However, the petitioner has stated that he had engaged Mr Halvonik to track the fee which clearly establishes that he was aware of the need to pay the fee. Furthermore, Mr Halvonik, being suspended at least for the time the when the fee could have been paid under the unintentional standard, and not currently in practice at that time, was unavoidably prevented from making the payment after his suspension. The only thing Mr Halvonik could have done would have been to contact Mr. Possidento, but Mr Halvonik was not currently in practice at that time and did not do so.

The PTO further states that there is nothing in the record to establish that the attorney (Halvonik) had steps in place to ensure the fee was paid on time. Whether or not Mr. Halvonik had procedures in place to track the fee is not known, but Mr. Possidento reasonably relied upon Mr. Halvonik to have such procedures. It is not, obviously, incumbent upon patentee to personally visit his attorney's office to determine what procedures were in place, nor would he be qualified to determine if such procedures would be adequate.

It should also be noted that the PTO has accepted delayed payment in several cases with similar fact patterns. For example, In re Patent No. 6,000,448 (Mar. 21, 2006) (Docket # 17, Decl. of Donald R. Steinberg in support of Pl.'s Cross-Mot. for Summ. Judgment, Ex. X) (finding unavoidable delay where the patent holder had not paid the maintenance fee, *was unaware of his obligation to do so*, and could not locate his attorney during the relevant time period(emphasis added)). Indeed, it is well established that there are circumstances where the action or non-action of a patentee's representative has resulted in a patentee meeting the unavoidable standard. See also, In re Patent No. 6,160,836 (Apr. 2, 2007) (Docket # 17, Ex. 5) (PTO found unavoidable delay where patent holder's attorney failed to forward the required payment to the PTO, and had been suspended from practicing before the PTO; reasoned "[g]iven the facts and circumstances of this case, in particular the suspension of petitioner's prior attorney, it is concluded that petitioner, has established that the delayed payment of the maintenance fee was unavoidable"); In re Patent No. 5,455,569 (Mar. 4, 2003) (Docket # 17, Ex. 4) (concluding that the patent holder had demonstrated unavoidable delay); and In re Patent No. 5,125,742 (Feb. 25, 1999) (Docket # 17, Ex. 6) (same). CIVIL ACTION NO. 08-12119-RWZ, SPRINGUARD TECHNOLOGY GROUP INC.v.UNITED STATES PATENT AND TRADEMARK OFFICE, *et al.* (UNITED STATES DISTRICT COURT DISTRICT OF MASSACHUSETTS) These cases all involve situations where an attorney had been disbarred/suspended.


Petitioner does not have any documentary evidence of a contractual arrangement between himself and Halvonik but was ensured by Mr. Halvonik that the fees would be monitored. The arrangement apparently (as far as patentee can recall) was that Mr. Halvonik would charge a fee for submitting the fees when they came due, but the petitioner does not have documents to that effect.

Finally, the PTO asserts that there is no nexus between the suspension of the attorney and the expiration of the patent. First, Mr. Halvonik was apparently suspended for part of 2005 when he should have been informing Petitioner that the fees were due. At that time Mr. Halvonik was embroiled in a case with the PTO (HALVONIK v. DUDAS, 398 F.Supp.2d 115 (2005) regarding his suspension and it is unclear whether or not he was maintaining client contact during that time but he certainly never sent any notification to patentee during that period perhaps because he was either unclear about his duties or actually suspended for the entire period of time when a notice to petitioner might have been sent. Halvonik was suspended for at least a part of the period when he could have informed patentee that the fees were due or, subsequently, that the patent had expired. It is clear that he was suspended during the 2 year period when patentee could have simply paid the fee no questions asked, this option being available until 1/29/2008. At the very

least, patentee was denied the option of paying the fee under the unintentional standard by Halvonik's suspension. That is to say, that while the patent *may* have expired while Halvonik was still active, there was still time to remedy the situation after Halvonik's suspension. While Patentee did not receive notice from Halvonik or the PTO regarding his maintenance fee before the patent expired, he could have still received notice of the patent expiration before 2008 but did not because of Halvonik's suspension.

Accordingly, it is believed that the Director should grant the petition for reconsideration and accept the previously enclosed maintenance fee payment.

2. Enclosed please find a check for \$400.00.

  
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SIGNATURE OF ATTORNEY  
Reg. No.:33,512

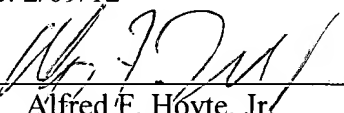
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#### **CERTIFICATE OF MAILING**

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed "Commissioner of Patents and Trademarks, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 " on the date below.

Date: 2/09/12

  
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